

**REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 3-6, and 8-36 are now present in this application. Claims 1, 4, 9, 14, and 29 are independent. By this Amendment, claims 2 and 7 have been canceled, without prejudice or disclaimer and claims 1, 4, 9, 14, and 29 have been amended. Reconsideration of this application, as amended, is respectfully requested.

**Request for Withdrawal of Finality of Office Action**

Applicant respectfully submits that the failure to properly treat claim 14 on the merits necessitates that the finality of the previous Office Action be withdrawn. Claim 14 has been rejected by the Examiner under 35 U.S.C. §102 as anticipated by Santilli et al. However, claim 14 depends from claim 10 which, according to the Examiner, is not anticipated by Santilli et al. (instead the Examiner rejected claim 10 under 35 U.S.C. §103). Accordingly, the rejection of claim 14 is improper and cannot be understood.

It is impossible for Applicant to understand from the Office Action whether claim 14 is actually rejected under 35 U.S.C. §102, or if it instead could have been rejected under 35 U.S.C. §103 (which it was not). Therefore, Applicant cannot properly respond to a rejection which does not set forth the correct section of the law being applied in the rejection.

Applicant has rewritten claim 14 in independent form for the Examiner's consideration without making any additional amendments thereto, since it is believed that claim 14 is allowable.

**Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 1, 3-4, 6-9, 11, 13, 14, 16-17, 19-24, and 26-36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,655,374 to Santilli et al. ("Santilli"). Claims 2, 5 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Santilli. Claim 12 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Santilli, in view of U.S. Publication No. 20030029173 to Bell et al. ("Bell"). Claims 15 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Santilli, in view of U.S. Patent No. 4,777,802 to Feher. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Santilli, in view of RU 2122658 C1 to Balkind et al. ("Balkind"). These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

In light of the foregoing amendments, Applicant respectfully submits that these rejections have been obviated and/or rendered moot. While not conceding to the Examiner's rejections, but merely to expedite prosecution, as the Examiner will note, independent claims 1, 4, 9, and originally dependent claim 29 (now independent) have been amended.

**Independent Claim 1**

Independent claim 1 has been amended to incorporate subject matter from dependent claim 2. Specifically, independent claim 1 is directed to a wearable cooler including, *inter alia*, "the at least one first heat sink being provided at an outside of the clothes."

In rejecting dependent claim 2, the subject matter of which is incorporated into amended claim 1, the Examiner correctly notes that Santilli does not disclose location of the heat sink outside

of the clothes. The Examiner alleges “[l]ocation of the heat sink either in side [sic] the cloth or outside the cloth is a mere design choice and there is no criticality or unexpected result for it. The Examiner failed to acknowledge Applicant’s argument regarding this point. Namely, the surgical suit described in Santilli is specifically for operating in sterile environments. As such, the entire heat exchange mechanism must be provided within the surgical suit. Otherwise, contamination will result. Air is provided into and out of the surgical suit through specifically defined ducts with filters so that contamination with the surrounding environment is kept to a minimum. Indeed, Santilli states “the present invention provides an ‘isolated’ system in the sense that the ambient air brought into the suit 10 is drawn through a filter disposed upstream of the intake duct 66. After air has been passed over the user’s face and upper body, it is discharged through a filter disposed downstream of the duct 52. Accordingly, the head and upper body of the user are completely isolated from the ambient atmosphere.” See *Santilli*, column 7, lines 45-51.

M.P.E.P. § 2144.04(VI)(C), notes that “[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.” (Citations omitted.)

Clearly, the location of the cooling device being inside the surgical suit as disclosed in Santilli is a requirement, and not a design choice. Therefore, Santilli cannot teach or suggest the features of claim 2 now incorporated into independent claim 1. Indeed, Santilli actually teaches away from these features.

For that reason, Santilli cannot anticipate or render obvious independent claim 1 and the claim should be allowed.

#### **Independent Claim 4**

Independent claim 4 has been amended to incorporate subject matter from dependent claim 7. Specifically, independent claim 4 is directed to a wearable cooler including, *inter alia*, “the at least one outlet is provided in all directions at the external case.”

The Examiner states that fan 90 of Santilli has a cover 64 with an air inlet and inherently has an air exit. The Examiner postulates that even though Fig. 4 does not specifically show the air outlet, it must have an air outlet. The Examiner is correct in that cover 64 includes a pair of outlet openings 88 disposed on either side of the upper portion of the cover 64. However, Santilli fails to show or describe the pair of outlet openings being provided in all directions at the external case.

As described by Applicant, the outlet openings being provided in all directions at the external case is shown in Figs. 3, 5, and 6. See paragraph [0037] of Applicant’s specification. Because Santilli fails to show or describe such a relationship, Santilli cannot anticipate independent claim 4.

For that reason, Santilli cannot anticipate or render obvious independent claim 4 and the claim should be allowed.

#### **Independent Claim 9**

Independent claim 9 is directed to a wearable cooler including, *inter alia*, “wherein the at least one first fan is directly above the corresponding at least one first heat sink such that the air flows out from the at least one first heat sink in all directions.”

Cover 64 of Santilli includes a pair of intake openings 86 and a pair of outlet openings 88 disposed on either side of the cover 64. From Figs. 1, 2, and 4, it is apparent that the pair of outlet openings 88 are aligned with metal heat dissipating plates 84 so that when fan 90 draws air in through the intake openings 86, the air is blown along the heat dissipating plates 84 and out through the outlet openings 88. *See* Santilli, col. 4, lines 36-63. Therefore, Santilli discloses an arrangement where the air flows out in two directions (*i.e.*, towards the outlet openings 88 arranged on opposite sides of the cover), not in all directions as recited in independent claim 9.

For that reason, Santilli cannot anticipate or render obvious independent claim 9 and the claim should be allowed.

#### **Independent Claim 29**

Dependent claim 29 has been rewritten in independent form and is directed to a wearable cooler including, *inter alia*, "the at least one second heat sink including a cavity portion" and "the at least one second fan is being placed within the cavity portion of the at least one second heat sink."

The Examiner alleges that Santilli discloses the heat sink cavity portion as being the portion where the fans 90, 76 reside. Applicant respectfully disagrees with this assertion because claim 29 requires that the at least one second heat sink includes a cavity portion. As shown in Fig. 4 of Santilli, the fan 76 is disposed downstream from the heat abstraction plates 80 and causes air to be drawn past the heat abstraction plates 80. Therefore, Santilli does not show a fan being placed within a cavity portion of a heat sink as required by the claim.

For that reason, Santilli cannot anticipate or render obvious claim 29 and the claim should be allowed.

**Dependent Claims 3, 5, 6, 8, 10-13, 15-28, and 30-36**

Dependent Claims 3, 5, 6, 8, 10-13, 15-28, and 30-36 depend from one of independent claims 1, 4, 9, and 14 and are allowable for at least the same reasons as the independent claims from which they depend, as well as for their additionally recited subject matter.

**Additional Cited References**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

**Office Action**

Further, the Office Action contains numerous characterizations of the invention, the claims, and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

**Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response

has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

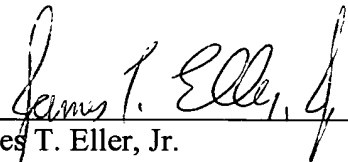
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Chad D. Wells, Reg. No. 50,875, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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